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U.S. Appl. No. 10/813,745
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Page 36 of 38II. REMARKS

Applicants respectfully request reconsideration of this application in view of the above amendments and the following remarks.

1. Status of the Claims

Claims 1-40 are pending in this application and subject to restriction/election. In this response, Claim 40 is being canceled and Claims 32-37 are being withdrawn. Accordingly, Claims 1-31, 38 and 39 are pending for examination on the merits.

2. Summary of the Amendments

Claim 40 has been canceled without prejudice or disclaimer of the subject matter.

3. Restriction Requirement

The Examiner has indicated that restriction to one of the following inventions is required under 35 U.S.C. §121:

- I. Claim 19, drawn to compounds of formula III, classified in class 546, subclass 155.
- II. Claim 20, drawn to compounds of formula IV, classified in class 548, subclass 556.
- III. Claims 1-18, 21-31 and 38-40, (less the compounds of Claims 19 and 20) classified in various classes and subclasses depending on the particular species.
- IV. Claim 32 drawn to a composition comprising a compound from Groups I-III, further comprising a steroidal anti-inflammatory agent classified according to the individual species and/or additional therapeutic agent.
- V. Claim 33 drawn to a composition comprising a compound from Groups I-III, further comprising a PDE4 inhibitor classified according to the individual species and/or additional therapeutic agent.

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VI. Claims 34-36 drawn to a method of treating pulmonary disorders, providing bronchodilation or treating COPD and asthma classified in class 514, subclasses 312, 386+.

VII. Claim 37 drawn to a method of studying a biological system or sample comprising a muscarinic receptor or a B2 adrenergic receptor classified in class 435, subclass 503.

In response, Applicants elect Group I with traverse in part. Specifically, Applicants respectfully traverse the requirement for restriction of Groups I, II and III for the following reasons.

In the present case, the Examiner has indicated that Groups I-III are inventions having independent and distinct chemical structures which lack a substantial structural feature recognized in the art as being essential to the disclosed utility as evidenced by their different classification (See Office Action at page 4, lines 01-03). Applicants respectfully disagree. The compounds encompassed by Groups I-III have a common core structure, i.e., formula I, and a common utility, e.g., bronchodilation, which utility is directly related to the common core structure (see Applicants' specification at page 2, lines 02-15).

Moreover, even if the Examiner's statements are true, the Examiner can search and examine the compounds of formula I as a group using electronic substructure search tools without serious burden. MPEP § 803 states, in part, that "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." MPEP § 803 at 800-4 (emphasis added). The standard set forth by the MPEP is serious burden not just additional burden. The mere fact that certain functional groups or ring systems may be in different classes based on historical search criteria does not automatically impose a serious burden on the Examiner. The compounds of formula I have a sufficient common core structure to allow the Examiner to search and examine Groups I-III together without serious burden.

For the forgoing reasons, Applicants respectfully request that the requirement for restriction of Claims 1-31 and 38-40, under 35 U.S.C. §121 be withdrawn.

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3. Election of Species

The Examiner has indicated that an election of species is required. In response, for purposes of an initial search and examination, Applicants elect the compound of formula III where R^4 is $-(CH_2)_5-$. This compound is disclosed on page 84, lines 22-30 of Applicants' specification (as Example 1).

Claims 1-14, 18, 19, 21-25, 29 and 30 read on the elected species.

4. Information Disclosure Statements

Applicants note that an Information Disclosure Statement for this application was filed on December 13, 2004. Applicants respectfully request that the Examiner return an examiner-initiated copy of the submitted PTO/SB/08a (Substitute PTO 1449) form with the first Office Action on the merits.

III. CONCLUSIONS

Reconsideration of this application in view of the above remarks is respectfully requested. Should there be any questions regarding this paper or this application, Examiner is encouraged to telephone the undersigned attorney for Applicants at (650) 808-6406.

Respectfully submitted,
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